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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/273,149	03/19/1999	KEVIN M. PINTAR	22074661-255	6715

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BAKER & MCKENZIE
805 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

16

Office Action Summary

Application No.

09/273,149

Applicant(s)

PINTAR ET AL.

Examiner

CESAR B PAULA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to the application filed on 12/31/01.

This action is made Final.

2. Claims 1-20 are pending in the case. Claims 1, 8, and 15 are independent claims.
3. The rejections of claims 1-6, and 8-20 under 35 U.S.C. 103(a) as being unpatentable over KUWAHARA (Pat. # 6,202,072, 3/13/2001, filed on 12/5/1997) have been withdrawn as necessitated by the amendment.
4. The rejection of claims 7, and 14 under 35 U.S.C. 103(a) as being unpatentable over KUWAHARA, in view of Mcallum (Pat. # 5,784,635, 7/21/98) have been withdrawn as necessitated by the amendment.

Drawings

5. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, and 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over KUWAHARA (Pat. # 6,202,072, 3/13/2001, filed on 12/5/1997) in view of Alam et al, hereinafter Alam (Pat. # 6,336,124, 1/1/2002, provisional filed on 10/1/1998).

Regarding independent claim 1, Kuwahara discloses: *A method of converting a plurality of input field--*“the present invention generates a conversion form for conversion between a prototype document.....and a document type definition ...conversion form can be so that it can be referred to when converting a plain document...to a SGML document” (Col. 2, lines 22-67). Kuwahara teaches above, the conversion of an input source data file into a second output file by using an optimized form generated at runtime for converting an input textual document into SGML format.

Moreover, Kuwahara discloses: *(a) receiving a first attribute of a first input field type and a second attribute--*“Three types of information, as shown in Fig. 2, such as a prototype of a plain text document, document type definition....is required for preparation of a SGML conversion form” (Col. 5, lines 25-67). KUWAHARA teaches above, the conversion of an input plain text document with a first attribute or format into a second output SGML file with a second format attribute for the creation of a conversion form.

Moreover, KUWAHARA discloses: creating at runtime an optimize form for converting a text document to SGML--“The SGML conversion form generation module 101 generates a SGML conversion form file...Three types of information, as shown in Fig. 2, such as a prototype of a plain text document, document type definition....is required for preparation of a SGML conversion form” (Col. 5, lines 25-67, and Col. 7, lines 26-67). KUWAHARA fails to explicitly teach *(b) creating a first optimized conversion routine...including one or more computer*

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instructions to be executed..(c) executing said first optimized conversion routine from said application program. Alam teaches the insertion, and execution of an executable program, such as JAVAscript, into an output document to enable conversion of an input document to the appropriate output document (col.2, lines 12-67, and col.20, lines 8-col.22, line 67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Kuwahara, and Alam, because Alam teaches the efficient and accurate conversion of an input document to an output document (col.1, lines 24-67).

Claims 2-3 is directed towards a method for performing the steps of claim 1, and are therefore similarly rejected.

Regarding claim 4, which depends on claim 1, KUWAHARA discloses: *performed dynamically while said application program is executing--* KUWAHARA discloses: “creating at runtime an optimize form for converting a text document to SGML--“The SGML conversion form generation module 101 generates a SGML conversion form file...Three types of information, as shown in Fig. 2, such as a prototype of a plain text document, document type definition....is required for preparation of a SGML conversion form” (Col. 5, lines 25-67, and Col. 7, lines 26-67). KUWAHARA teaches above, invoking a program for the dynamic creation of an optimized conversion form for converting a text document to SGML format.

Claims 5-6 is directed towards a method for performing the conversion of a prototype text document, which includes input fields, and an SGML document DTD having output fields, found claim 1, and are therefore similarly rejected.

Claims 8-12 are directed towards a method for performing the steps of claims 3, 2, 4, 6, and are therefore similarly rejected.

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Regarding claim 13, which depends on claim 8, KUWAHARA discloses: *input and output attribute are date type*--“The SGML conversion form generation module 101 generates a SGML conversion form file...Three types of information, as shown in Fig. 2, such as a prototype of a plain text document, document type definition...is required for preparation of a SGML conversion form” (Col. 5, lines 25-67, Col. 7, lines 26-67, and Fig. 6). KUWAHARA teaches above, invoking a program for the dynamic conversion of an input prototype document into the SGML document, which has a “date” attribute in output field “b”.

Claims 15-20 are directed towards a computer system for implementing the steps found in claims 1-4, 13, and 6 respectively, and are similarly rejected.

8. Claims 7, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over KUWAHARA, in view of Alam, and further in view of Mcallum (Pat. # 5,784,635, 7/21/98).

Regarding claim 7, which depends on claim 1, KUWAHARA teaches: “The SGML conversion form generation module 101 generates a SGML conversion form file...Three types of information, as shown in Fig. 2, such as a prototype of a plain text document, document type definition...is required for preparation of a SGML conversion form” (Col. 5, lines 25-67, and Col. 7, lines 26-67). KUWAHARA fails to explicitly teach *generating program debugging instrumentation*. Mcallum discloses: “This updating process, thus, not only corrects keying errors and standardizes syntax” (Col. 5, lines 35-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to have debugged the routine, because Mcallum teaches above, the generation of cleaning routines for correcting error syntax rules.

Claim 14 is directed towards a computer system for implementing the steps found in claim 7, and is similarly rejected.

Response to Arguments

9. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. The Applicant note that Kuwahara fails to teach or suggest the changes made to the claims (p.4,L.1-3). The Examiner has performed a new search and consideration of the claims as amended. The search has yielded a new prior art reference relevant to the claims. The Applicant is directed towards the rejections above, based upon the newly found prior art.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wu et al. (Pat. # 6,263,344), and Fong et al. (Pat. # 6,279,015).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office
Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry)

Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label "PROPOSED" or "DRAFT").

Application/Control Number: 09/273,149

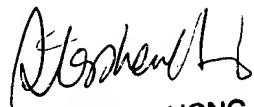
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**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).**

CBP

2/22/02


STEPHEN S. HONG
PRIMARY EXAMINER